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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/990,821	11/21/2001	Jay S. Walker	98-054-C1	4569

7590 11/30/2004

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EXAMINER

THAI, CANG G

ART UNIT	PAPER NUMBER
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3629

DATE MAILED: 11/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/990,821	WALKER ET AL.	
	Examiner	Art Unit	
	Cang G. Thai	3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on November 21, 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>November 21, 2001</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Priority

An application in which the benefits of an earlier application are desired must contain a specific reference to the prior application(s) in the first sentence of the specification or in an application data sheet (37 CFR 1.78(a)(2) and (a)(5)). The specific reference to any prior non-provisional application must include the relationship (i.e., continuation, divisional, or continuation-in-part) between the applications except when the reference is to a prior application of a CPA assigned the same application number.

This application is the benefits of an earlier Continuation Application No. 09/219,220 filed on December 23, 1998.

Information Disclosure Statement

1. The information disclosure statement (IDS) submitted on November 21, 2001. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the examiner is considering the information disclosure statement.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 1-6 are rejected under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter.

In order for the claimed invention to be statutory subject matter, the claimed invention must fall within one of the statutory classes of invention as set forth in U.S.C.

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§ 101 (i.e. a process, machine, manufacture, or composition of matter which has practical application in the technological arts).

In the present case, Claims 1-6 are directed to a method product for “dynamically generating a menu”, which is not within one of the classes of invention set forth in U.S.C. § 101.

The method product for “dynamically generating a menu” comprising:

- a) automatically determining a price associated with a menu item based at least partly on revenue management information;
- b) receiving a request for a menu; and
- c) generating a menu, including the automatically determined price, in response to the request for a menu.”

In the above claim, it is merely an abstract idea and does not produce a useful, tangible, concrete results-which has practical application in the technological arts.

The method product for the “dynamically generating a menu” comprising the steps of (a)-(c) as shown are merely an abstract idea and does not reduce to a practical application in the technological arts (i.e. interaction in the steps with the computer/computer network or other equivalent means) and are therefore are found to be non-statutory. See *In re Alappat*, 33 F.3d at 1544, 31 USPQ2d at 1557, or *In re Waldbaum*, 173 USPQ 430 (CCPA 1972) or *In re Musgrave*, 167 USPQ (CCPA 1970) and *In re Johnston*, 183 USPQ 172.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1, recites “dynamically” and “ menu”. The preamble mentions the term “dynamically” which normally means “designating or of memory that requires periodic renewal of its stored data”, but there is not step of “renewing/updating” the stored database for generating a menu. It is also not clear no the relationship of the term “menu” in steps (a), step (b) and step (c). It appears that they should be related, but no positive language showing the relationship has been shown.

Double Patenting

Claims 1-6 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claim 1 of U.S. Patent No. 6,341,268 (WALKER ET AL.). Although the conflicting claims are not identical, they are not patentably distinct from each other because each of the recite limitation in Claim 1 of the instant application is encompass each of the recite limitations in Claim 1 of WALKER ET AL., except the phase “wherein the automatically determined price associated with the menu item is further based at least partly on information related to a customer associated with the request for a menu” in WALKER ET AL.

The non-statutory double patenting rejection is based on the judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.32(c) may be used to overcome an actual or provisional rejection based on a non-statutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1-6 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,061,691 (FOX).

As for Claim 1, FOX discloses a method of dynamically generating a menu, comprising:

- a) automatically determining a price associated with a menu item based at least partly on revenue management information {Column 2, Lines 27-29, where this reads over "a need for a system that can improve pricing accuracy by providing automatic updating of the pricing forecast, so that in an optimum state the effect of each order on the pricing forecast is taken into account before the next order is placed"}. It appears that the teach of step (a) must carry out before receiving a request for a menu;
- b) receiving a request for a menu {Column 3, Lines 26-27, wherein this reads over "receiving a customer request for an inventory item"}; and
- c) generating a menu, including the automatically determined price, in response to the request for a menu {Column 4, Lines 29-31, wherein this reads over "generating a table menu one or more inventory items that most closely correspond to the customer request using a price forecasting system"}.

As for Claim 2, FOX discloses the step of automatically determining a price comprises of adjusting a prior price associated with the menu item based at least partly on the revenue management information {Column 3, Lines 45-50, wherein this reads over "price changes caused by a reduction in available inventory due to the customer request are taken into account, and the pricing data accessed by the price forecasting

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when a price quotation is generated is updated prior to repeating the process for a subsequent customer request”}.

As for Claim 3, FOX discloses the revenue management information comprises information related to the previous sales of the menu item {Column 3, Lines 47-50, wherein this reads over “the pricing data accessed by the price forecasting when a price quotation is generated is updated prior to repeating the process for a subsequent customer request”}.

As for Claim 4, FOX discloses the revenue management information comprises information related to inventory of the menu item {Column 3, Lines 59-63, wherein this reads over “pricing data is calculated by the yield management system in a manner consistent with a pricing strategy implemented by the yield management so that the price changes caused by the change in available inventory due to the change to the customer's order are taken into account”}.

As for Claim 5, FOX discloses the information related to inventory comprises information selected from a group including:

- i) a current amount of inventory {Column 1, Lines 27-29, wherein this reads over “type and quality of information pertaining to the value of available inventory, at a particular moment in time, relative to other available inventory”},
 - ii) a predicted amount of inventory {Column 1, Lines 30-32, wherein this reads over “unit of inventory has much different value depending upon when the inventory is required by a customer”},
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- iii) an age of inventory {Column 1, Lines 32-34, wherein this reads over "the particular unit of inventory can be sold at a later date for at least as much revenue, relative to all other remaining"}, and
- iv) a price paid for inventory {Column 1, Lines 66-67 and Column 2, Lines 1-3, wherein this reads over "the value remaining inventory at the time at the availability request, as the inventory relates to total original capacity for each program or time segment available for sale at a designated cost efficiency parameter"}.

As for Claim 6, FOX discloses the revenue management information comprises previous revenue management information associated with at least previous same days-of-weeks {Column 7, Lines 35-38, wherein this reads over "price forecasts extend as far as 52 weeks from current week, providing a pricing structure that guards against selling rates that are too low when large amounts of inventory available"}.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

I. U.S. Patent:

- 1) U.S. Patent No. 5,873,069 (REUHL ET AL.) is cited to teach automatic updating and display of retail prices,
 - 2) U.S. Patent No. 6,208,976 (KINEBUCHI ET AL.) is cited to teach order management system with automatic menu updating,
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- 3) U.S. Patent No. 6,055,513 (KATZ ET AL.) is cited to teach method and apparatus for intelligent selections of goods and electronic commerce, and
- 4) U.S. Patent No. 5,839,115 (COLEMAN) is cited to teach restaurant management system.

II. Foreign Patent:

- 1) WO 91/07715 (PHILLIP SAMERUS) is cited to teach data entry.

III. Non-Patent Literature:

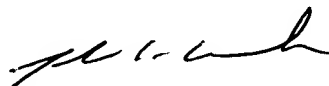
- 1) W.E. Mattis, "A New Modern Structure for Data Transmission," November 1993, IEEE Transactions on Consumer Electronics, volume 4, pp.878-886.
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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cang G. Thai whose telephone number is (703) 305-0553. The examiner can normally be reached on 6:30 AM - 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (703) 308-2702. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

CGT 11-12-2004



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